

REMARKS

Claims 1-25, 33-36, and 38 are pending in the present application. Claims 26-32 are withdrawn subject to a restriction requirement, and claim 37 is cancelled. Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the office action of May 10, 2006, the following actions were taken:

- (1) claims 6, 20, 31 and 35 were rejected under 35 U.S.C. 112, second paragraph as being indefinite;
- (2) claims 1, 4, 6, 8, 9, 12, 13, 15, 33 and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219;
- (3) claims 1, 4-6, 8-15, 33 and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219 and JP 58-008357;
- (4) claims 1, 4-15, 33 and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219 and JP 58-008357, in view of U.S. Published Application No. 2001/0039895 ("'895") and/or U.S. Patent No. 5,470,816;
- (5) claims 1, 4-15, 17, 20-25, 33, 35 and 38 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219 and JP 58-008357 in view of U.S. Patent No. 5,362,536 ("'536"), U.S. Patent Application No. 2003/0108708 ("'708") or WIPO Published Application No. WO 03/032299 ("'299");
- (6) claims 1-16, and 33-35 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219 and JP 58-008357 in view of U.S. Patent No. 2,957,004 ("'004") or U.S. Patent No. 4,284,704 ("'704");
- (7) claims 1-25, 33-35 and 38 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219 and JP 58-008357, combined with either '004 or '704, in view of '536, '708, or '299;
- (8) claims 1-25 and 33-38 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219 and JP 58-008357, combined with either '004 or '704 in view of '536, '708, or '299, further in view of U.S. Patent No. 4,508,811 ("'811") and Melles Griot Catalog (1995/96) pp. 49-4 through 49-5; and

(9) claims 1-25 and 33-38 were provisionally rejected for nonstatutory obviousness-type double patenting as being unpatentable over claims 1-38 of copending Application No. 10/867518 (U.S. 2005/0274274).

It is respectfully submitted that the presently pending claims be examined and allowed. Applicants submit that each and every amendment herein, and throughout the prosecution of the present application is fully supported by the specification as originally filed, and that no new matter has been added.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 6, 20, 31 and 35 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner instructs that “polymethyl indolium” should read “polymethine indolium”. The Applicant respectfully disagrees. Polymethyl indolium is the chemical used throughout the specification and is appropriately used in the claims.

Additionally, the Examiner has rejected claims 10, 11, and 23 under 35 U.S.C. § 112, second paragraph. The Examiner states that “ethyl acetate butyrate” is confusing. In response, the Applicant respectfully disagrees. Ethyl acetate butyrate indicates a compound including a butyrate, an ethyl group, and an acetate group. Such interpretation of this term would be apparent to one of ordinary skill in the art. As such, neither the specification nor the affected claims have been amended.

Based on the arguments above, the Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

Rejections Under 35 U.S.C. § 103

The Examiner has rejected all of the presently pending claims over one or more references in combination. The Applicant respectfully submits that these claims are patentable over the cited references for the reasons set forth below, and that the rejection should be withdrawn.

Before discussing the obviousness rejections herein, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie*

obviousness by showing the prior art reference, or references combined, teach or suggest all the claim limitations in the instant application. Further, the Examiner has to establish some motivation or suggestion to combine and/or modify the references, where the motivation must arise from the references themselves, or the knowledge generally available to one of ordinary skill in the art. The Applicant respectfully asserts the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in any of the rejections.

The RD 39219 Reference

Claims 1, 4, 6, 8, 9, 12, 13, 15, 33 and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219. RD 39219 introduces an imaging medium for thermal imaging applications with near infrared radiation. The medium includes 1,3-diiminoisoindoline and/or a related phthalocyanine precursor material, a thermally cleavable adduct capable of generating a phenolic compound with reducing properties, and a near infrared absorbing dye. RD 39219 also lists binders as a possible addition to the composition.

The two independent claims (claims 1 and 33), from which all other noted claims depend have been amended to include the requirement of development in less than about 1 msec when exposed to about 30 mW to about 50 mW of infrared radiation. RD 39219 does not teach development in less than 1 msec under any conditions, let alone when exposed to about 30 mW to about 50 mW of infrared radiation.

As a further matter, it is respectfully pointed out that claim 33 is specifically drawn to the a system which utilizes an optical disk substrate coated with a color forming composition, and the system is configured to direct infrared radiation having a wavelength of from about 760 nm to less than 800 nm to the color forming composition. This is neither taught nor suggested by RD 39219.

As such, RD 39219 does not teach each and every element of the claims and therefore, the Applicant requests withdrawal of the rejection of claims 1, 4, 6, 8, 9, 12, 13, 15, 33 and 35 under 35 U.S.C. 103(a) as being obvious over RD 39219.

The JP 58-008357 Reference

The JP 58-008357 reference allegedly discloses a thermographic copying paper obtained by coating a transparent or semitransparent support with a 1-amino-3-iminoisoindolenine derivative together with a metal salt of an organic acid or a metal

complex to form a heat-sensitive layer. Claims 1, 4-6, 8-15, 33 and 35 were rejected under 35 U.S.C. 103(a) as being obvious over RD 39219 and JP 58-008357.

JP 58-008357 is in Japanese, and as such, has not been read in whole by the Applicant. However, in searching through the Japanese specification for numeric symbols, it does not appear as though the reference teaches development in less than about 1 msec when exposed to about 30 mW to about 50 mW of infrared radiation. Therefore, there is an element of each claim (specifically each independent claim) that does not appear to be taught in the combination of references.

As a further matter, it is respectfully pointed out that claim 33 is specifically drawn to the a system which utilizes an optical disk substrate coated with a color forming composition, and the system is configured to direct infrared radiation having a wavelength of from about 760 nm to less than 800 nm to the color forming composition. This does not appear to be taught or suggested by RD 39219.

Additionally, the Examiner has relied on the body of the text without providing a translated version of the reference. According to M.P.E.P. 706.02, section II:

If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. (Under Section II, titled Reliance Upon Abstracts and Foreign Language Documents in Support of a Rejection)

It appears clear from the wording of the Office Action, particularly pointing to portions of the body of the reference, that the Examiner intended to rely on the document as a whole. As the Examiner has failed to provide a proper translation or put a translation on the record, the Applicant asserts that it was improper for the Examiner to rely on the body of the reference.

Therefore, the Applicant respectfully requests the Examiner withdraw the rejection based either on the lack of a *prima facie* case due to the lack of the development element and/or because the citing of the reference was improper. Alternatively, if the Examiner wishes to maintain the rejection, please provide an appropriate translation for the Applicant to consider as a whole.

Other Rejections

All other rejections are based on obviousness, using RD 39219 and/or JP 58-008357 as primary references in combination with or in view of other references. These references cited alone or in combination are deficient in their teachings for the same reasons set forth above. Specifically, regarding the rejections that utilize JP 58-008357, a Japanese document, as the primary reference, without providing a translation or placing a proper translation on the record is improper. As such, the rejections based on the reference are also improper. Therefore, the Applicant respectfully requests withdraw of the rejections based on JP 58-008357, or alternatively, a full translation so that the Applicant can consider the merits of the combinations as a whole.

Further, the balance of the rejections utilize other secondary references, none of which remedy the deficiencies of the primary references cited. Specifically, '536 (Fleming) does not cure the defects of the primary references, in that it does not teach of compositions that are developable using low power under fast development conditions as set forth in claim 1, and further, does not teach labeling of optical discs, as required by claim 33.

Additionally, when a rejection utilizes a 35 U.S.C. 102(e) reference that is assigned to Hewlett-Packard as part of a 103 rejection, it is not proper to use that reference reference under 35 U.S.C. 103(a). For example, all rejections that utilize '708 (Anderson) as part of a combination rejection would fall under 35 U.S.C. 103(c). The present application and the '708 application were both under an obligation to assign to HP at the time each invention was made, and thus, all rejections that utilize the '708 publication should be withdrawn.

Withdrawal of each of these rejections is respectfully requested

Rejections Based on Double Patenting

Claims 1-25 and 33-38 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-38 of copending Application No. 10/867518. A terminal disclaimer is filed herewith. Withdrawal of this rejection is respectfully requested.

In view of the foregoing, Applicants believe that claims 1-25, 33-36 and 38 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 10th day of August, 2006.

Respectfully submitted,



Gary P. Oakeson
Attorney for Applicant
Registration No. 44,266

THORPE NORTH & WESTERN, LLP
8180 South 700 East, Suite 200
Sandy, Utah 84070
(801) 566-6633

On Behalf Of:
HEWLETT-PACKARD COMPANY
1000 NE Circle Blvd., m/s 422B
Corvallis, OR 97330-4239
(541) 715-0159